Claims 1-18 are pending in the present application. Claims 1-17 were cancelled. Reconsideration of the claim 18 is respectfully requested.

I.   Examiner Interview

Applicants thank Examiner Alex Wang for courtesies extended Applicants' representative on June 4, 2008. During the interview, Applicants' representative pointed to differences observed between the *Kondo* and *Gaffney* references and the claims. No agreement was reached, however,

II.   35 U.S.C. § 103 Obviousness

The Examiner has rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Kondo et al. (Publication Number 2002/0069135, hereinafter '*Kondo*') and Gaffney et al. (Publication Number 2001/0012302, hereinafter '*Gaffney*').

The examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 in U.S.C. §103. *In re Fritch*, 972 F.2d. 1260, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness. *KSR International Co. versus Teleflex Inc.*, No. 04-1350 (U.S. April 30, 2007) (citing *In re Khan*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Additionally, the prior art reference (or references, when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

Claim 18 is recited as follows:

A method of automating the matching of business to business processes comprising:
receiving a registration request, via the Internet, from a first company;
receiving transmission capability from the first company based on the registration request, the transmission capability including at least one first process format;

receiving a registration request, via the Internet, from a second company

receiving transmission capability from the second company based on the registration request, the transmission capability including at least one second process format;

storing the transmission capability of the first company and storing the transmission capability of the second company;

receiving a request from one of the first company and second company to do business with the other company;

mapping at least one of the first process formats to at least one of the second process formats;

determining at least one transformation of at least one of the first process formats to at least one of the second process formats based on the mapping;

determining at least one translation path between the first and second companies based on the transmission capabilities and translation capabilities; and

sending at least one determined translation path, including the transmission capability of the first company and the transmission capability of the second company and the determined transformation to the first company and second company.

The Examiner uses the following passage to allege *Kondo* teaching the claim 18 recited, "receiving transmission capability from the first company based on the registration request, the transmission capability including at least one first process format".

> b. receiving information from the first company based on the registration request, the information including at least one first process format (page 2 [0035] page 3 [0036], figure 2, each company has its process format);

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FIG.2

BUSINESS ELECTRIC BROCHURE COMMON FORMAT

* Photographs or technical drawings of the products or parts relating to the production or processing (of representative products),

* Processing technology (the names of manufacturing processes, the accuracy of processing, the ranges and the shapes of processing, the materials to be processed, the occupational description, the list of plants and equipments, the list of persons qualified in the technical field and so forth),

* Standard certifications (JIS, ISO certification, ecological certification and other certification as obtained in the world),

* Business partners and the actual achievement thereof,

* Capacity of the plants and the standard turn-around times of the respective parts and products relating to the manufacturing and processing technology,

*Average volumes of orders and the prices of the respective parts and products relating to the manufacturing and processing technology

* Terms of transaction and payment (account opening, the method of payment, the terms of payment and so forth),

* Basic contract of transaction,

* Condition of packing and transportation,

* Skillful technology, the only one or number one technology and

* Other description

[0034] First, the servers 20 include a member database server which is provided with a member database in which is stored **member information about the respective members** of the multi-dimensional order making and receiving business matching system in accordance with the present embodiment. Also, the servers 20 include a web server which is connected to the member database server in order to update the **member information** and provide a front engine for the information search process. The web server then serves to return the unit(s) of information relating to an optimal want-to-buy company (companies) in response to the request from a member as a want-to-sell company (companies) as explained in the following description.

[0036] When the company selects the registration button after inputting the information as required, the information is registered in the member database and the company is given a member ID and a password for use in accessing the member-only pages. The procedure as described above is implemented with a CGI program, an SSL program and the like provided within the web server of the multi-dimensional order making and receiving business matching system. In the member-only pages, it is possible to modify or delete the contents of the information as registered.

Kondo paragraphs 0034 and 0036.

Kondo actually teaches storing information of a member business. *Kondo* merely teaches that member information is name of the company, the president of the company, the resident address, the telephone number, the facsimile number, the e-mail address, the URL, line of manufacturing, type of manufacturing, the sales scale, the bank of account, such as shown in

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Figure 2. *Kondo* emphasizes over and over the contact details, and type of business are only a work description. In contrast, claim 18 of the present invention recites, "the transmission capability including at least one first process format." *Kondo* does not teach a process format, and so, is unable to, as claim 18 recites, "receiving transmission capability from the first company based on the registration request, the transmission capability including at least one first process format". Consequently, *Kondo* lacks this feature.

Moreover, the "process format" is integral to additional recited features of claim 18. The Examiner further alleges a "process format" is taught in *Kondo* in the following passage:

> g. mapping at least one of the first process formats to at least one of the second process formats (page 1 [0013], page 2 [0034]);

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> [0013] In brief, the above and other objects and advantages of the present invention are provided by a multi-dimensional order making and receiving business matching system for matching a want-to-buy business and a want-to-sell business selected among from a number of want-to-sell businesses in the Internet, said system comprising:

> [0034] First, the servers 20 include a member database server which is provided with a member database in which is stored member information about the respective members of the multi-dimensional order making and receiving business matching system in accordance with the present embodiment. Also, the servers 20 include a web server which is connected to the member database server in order to update the member information and provide a front engine for the information search process. The web server then serves to return the unit(s) of information relating to an optimal want-to-buy company (companies) in response to the request from a member as a want-to-sell company (companies) as explained in the following description.

Kondo paragraphs 0013 and 0034.

Kondo actually teaches matching want-to-buy businesses with want-to-sell businesses. A business is typically an individual or group of individuals that provide goods or services for a fee. A business is clearly not the claim 18 recited, "process formats". In addition, claim 18 recites a mapping step. *Kondo,* instead, teaches a matching step. As such, *Kondo* is really teaching a kind of introduction service. For example, *Kondo* says that it relates a matching system for matching a want-to-buy business and a want to-sell business selected from a number of want-to-sell businesses (*Kondo* paragraph 0002). Kondo further states, "…it is not expected to fully activate the business unless a want-to-sell companies can be matched with a want-to-buy

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company in a pinpoint manner (*Kondo* paragraph 0009)". It is therefore important how to match a want-to-sell company to a corresponding want-to-buy company (*see Kondo* paragraph 0007). Accordingly, the cited paragraphs above all direct one of ordinary skill in the art to a **matching** of **businesses** and not to the claim 18 recited, "mapping at least one of the first process formats to at least one of the second process formats". Thus, Kondo does not teach each and every aspect of this feature of claim 18.

The Examiner also asserts that Kondo teaches the claim 18 recited, "determining at least one transformation of at least one of the first process formats to at least one of the second process formats based on the mapping". The Examiner alleges that the following paragraph teaches this feature:

> [0013] In brief, the above and other objects and advantages of the present invention are provided by a multi-dimensional order making and receiving business matching **system for matching a want-to-buy business and a want-to-sell business** selected among from a number of want-to-sell businesses in the Internet, said system comprising:
>
> [0035] Next, the procedure for matching a want-to-buy company with a want-to-buy company (companies) will be explained. At first, **a company making use of the multi-dimensional order making and receiving business matching system accesses to a new member registration page stored in the web server** of the multi-dimensional order making and receiving business matching system. The company inputs necessary information required for the registration to the new member registration page. Items of such information required for the registration are selected among from, for example, the name of the company, the president of the company, the resident address, the telephone number, the facsimile number, the e-mail address, the URL, the line of manufacturing work, the type of manufacturing/processing, the products, the sales scale, the bank of account and so forth. Some of the items may not be indispensable.

Kondo paragraphs 0013 and 0035 (emphasis added).

The following paragraph is particularly relevant:

> [0033] In the figure, the Internet is the network on which the multi-dimensional order making and receiving business matching system in accordance with the present invention is implemented and through which are connected server or client terminals 10 of the respective members. Also, **the multi-dimensional order making and receiving business matching system in accordance with the present embodiment is composed generally of a plurality of servers 20 each of which is connected to the Internet through a LAN (LOCAL AREA NETWORK) 30 and a router 40**. In the following description,

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the respective servers will be explained in details.
Kondo paragraph 0033 (emphasis added).

As can be seen, *Kondo* is merely teaching interconnection of servers through routers. Nothing whatsoever concerning the *Kondo* teaching of servers resembles the claimed, "process formats". As explained earlier, with reference to other cited *Kondo* paragraphs, "process formats" are not present in *Kondo*. Nevertheless, assuming for the moment, that the Kondo taught "server" is a process format, which it is not, Kondo does not arrange the server in the same manner as recited in claim 18. Importantly, Kondo lacks any teaching concerning the *transformation* of such servers, let alone the claim 18 recited, "process formats". The servers described in *Kondo* are unchanged from the beginning of any *Kondo*-described process to the end of such processes taught by *Kondo*. Evidently, *Kondo* is focused only on the matching of businesses through interconnecting servers, and not the claimed "transformation of at least one of the first process formats to at least one of the second process formats based on the mapping." Accordingly, for this additional reason, the *Kondo* reference fails to teach this feature of claim 18.

In addition, the *Gaffney* reference fails to cure these deficiencies of *Kondo*. *Gaffney* is directed to storing a message, translating the message in a translation unit into a format adapted to the presentation capabilities of a receiver's current terminal. (*see, Gaffney* abstract). The messaging system … [delivers] to the intended recipient of the message regardless of his/her current location. (*see, Gaffney* paragraph 0014).

The Examiner concedes that *Kondo* fails to teach the final two elements of claim 18.

> Kondo does not explicitly teach wherein the information are transmission capability and determining at least one translation path between the first and second companies based on the transmission capabilities and translation capabilities; and sending at least one determined translation path, including the transmission capability of the first company and the transmission capability of the second company and the determined transformation to the first company and second company.

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Moreover, the Examiner fails to allege that *Gaffney* teaches the claim 18 recited, "determining at least one translation path between the first and second companies based on the transmission capabilities **and translation capabilities**." In addition, the Examiner fails to allege

that *Gaffney* teaches the claim 18 recited, "sending at least one determined translation path, including the transmission capability of the first company and the transmission capability of the second company and the determined transformation to the first company and second company".

The Examiner does offer the following paragraph concerning *Gaffney*, which appears unconnected to any specific aspect of claim 18.

> However, Gaffney teaches a invention allows messages including multiple message types to be stored and delivered to and from a variety of terminal types over a plurality of interconnecting networks (page 1 [0001]), and translating message formats among a plurality of network devices with different transmission capabilities (page 1 [0012], page 2 [0020]).

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The Examiner has not made a *prima facie* case with respect to these two final elements of claim 18. Rejecting a claim under 35 USC § 103(a) without a showing teaching or suggesting all the claim limitations is wholly improper. Thus, for these additional reasons, Applicants have shown that the combination of *Kondo* with *Gaffney* lack at least four important features of the recited claim 18. Nevertheless, the Examiner cites *Gaffney* for some purpose.

> However, Gaffney teaches a invention allows messages including multiple message types to be stored and delivered to and from a variety of terminal types over a plurality of interconnecting networks (page 1 [0001]), and translating message formats among a plurality of network devices with different transmission capabilities (page 1 [0012], page 2 [0020]).

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The cited passages are copied below, for your convenience.

> The present invention relates to methods in a communication system which allow messages including multiple message types to be stored and delivered to and from a variety of terminal types over a plurality of interconnecting networks.

Gaffney paragraph 0001.

> Yet a further object of the present invention is to minimise the total need for message translation due to limited transmission capabilities of one or more specific interconnecting telecommunication networks.

Gaffney paragraph 0012.

> A messaging system for carrying out the above identified aspects of the invention comprises a multimedia message store where a copy of every message sent to or from the system is kept, **a translation unit for converting every message sent a**nd received into a message format best possibly suited for the presentation capabilities of the recipient's current terminal, a database which

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stores address references and terminal data for all users in the system and a control unit for controlling and coordinating the other units in the system. The messaging system according to the invention is hereby characterised by what is apparent from claim 10.

Gaffney paragraph 0020.

As can be seen, although the above passages teach a translation unit, nothing in *Gaffney* teaches the claim 18 recited, "determining at last one translation path between the first and second companies **based on the transmission capabilities and translation capabilities**". Furthermore, no "translation path" is mention, whatsoever, in *Gaffney*, nor does the Examiner appear to even allege that the claim 18 recited "translation path" is present in *Gaffney*. *Gaffney* merely teaches a telecommunication network. Accordingly, for these additional two reasons, neither *Gaffney* nor *Kondo* teaches the features of claim 18, and in particular, the final indented elements of claim 18.

Consequently, Applicant's respectfully urge that the Claim 18 is currently in a condition for allowance.

III.   Conclusion

It is respectfully urged that the subject application is patentable over *Kondo* and *Gaffney* and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: __06-18-2008_____

                                        Respectfully submitted,

                                        __/Robert C. Rolnik/____

                                        Robert C. Rolnik
                                        Attorney
Rolnik & Associates, P.C.   Reg. No. 37,995
24 N. Main St.
Kingwood, TX 77339
(281) 973-5342
Attorney for Applicants

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